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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,729	04/27/2005	Shigeyoshi Kouno	P27797	8751
7055 7590 12/11/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER TALBOT, MICHAEL	
			ART UNIT 3722	PAPER NUMBER
			NOTIFICATION DATE 12/11/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

## Office Action Summary

Application No.

10/532,729

Applicant(s)

KOUNO ET AL.

Examiner

Michael W. Talbot

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/20/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 3-10 in the reply filed on 15 October 2007 is acknowledged.

In Applicant's response dated 15 October 2007, a provisional election was made without traverse to prosecute the invention of Group II, claims 3-10. Therefore Groups I, III and IV comprising claims 1, 2 and 11-15 are withdrawn from further consideration by the examiner, pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: (1) character reference "41" shown in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly

labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

***Specification***

3. The disclosure is objected to because of the following informalities:

Refer to page 3, line 20, change the word "dap" to --tap-- within the phrase "at the dap die is an obstacle" so as to read --at the tap die is an obstacle--.

Refer to page 11, line 27, character reference "small diameter through hole 61" should be changed so as to read --small diameter through hole 61H--.

Refer to page 18, line 7, character reference "not-rotating head 181" should be changed so as to read --non-rotating head 181--.

Refer to page 20, line 7, change the word "he" to --the-- within the phrase "he prepared hole" so as to read --the prepared hole--.

Refer to page 21, lines 8 and 9, the two occurrences of character reference "space 46" should be changed so as to read --space 246--.

Appropriate correction is required.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities:

Claim 1 recites the limitation "the vertical direction" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo et al. '239. Endo et al. '239 shows in Figures 1-5 a tapping device (3,5,7,9,11) comprising a tap holder (37A,37B) provided in a shank body (27) which can be freely attached to a rotating mold indexing device (5) rotatably provided at a punch press (1) so as to be moveable in a vertical direction, the tap holder having a tap (49A,49B) at its lower end and being provided so as to be movable only in the vertical direction and urged upwards (via lifter spring 31). Endo et al. '239 shows a downward movement transmitter (13) for transmitting downward motion of a ram (13) provided at the punch press so as to be moveable in the vertical direction to the tap holder, the downward movement transmitter being at an upper part of the shank body. Endo et al. '239 shows a work piece brace (piece at bottom of 27 at 49A,49B) rotatably provided at a lower end of the shank body.

7. Claims 3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11005127. JP 11005127 shows in Figures 3 and 5 a tapping device (1,3) comprising a tap holder (7) provided in a shank body (31,33) which can be freely attached to a rotating mold indexing device (3) rotatably provided at a punch press so as to be moveable in a vertical direction, the tap holder having a tap (19) at its lower end and being provided so as to be movable only in the vertical direction and urged upwards (via lifter spring 13). JP 11005127 shows a downward movement transmitter (9,27,35) for transmitting downward motion of a ram (53) provided at the punch press so as to be moveable in the vertical direction to the tap holder, the downward movement transmitter being at an upper part of the shank body. JP 11005127 shows the downward movement transmitter having a pressing device (9) for pressing the tap holder downward by fluid pressure supplied from the ram (via 39,55) and a shock absorber (35).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. '239 in view of JP 11005127. Endo et al. '239 further shows an elastic member (45) which can freely transmit downward motion of the ram at the downward movement transmitter to lower the tap holder against upward energizing force of the tap holder. Endo et al. '239 lacks an oil channel for guiding oil supplied from the ram to the tap within the downward movement transmitter and the tap holder.

JP 11005127 shows in Figures 3 and 5 a tapping device (1,3) comprising a tap holder (7) provided in a shank body (31,33) and a downward movement transmitter (9,27,35) for transmitting downward motion of a ram (53). JP 11005127 shows an oil channel (55,39,41,43,45) for guiding oil supplied from the ram (via 55) to the tap within the downward movement transmitter and the tap holder (via 39,41,43,45). In view of this teaching of JP 11005127, it would have been obvious to one of ordinary skill in the art to modify the tapping device of Endo et al. '239 to include an oil channel from the ram to the tap as taught by JP 11005127 to provide coolant/oil mist to the cutting surface for reducing wear and heat generation at the tapping tool and work piece interface, thus increasing the tapping effectiveness and overall operational life expectancy.

10. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11005127 in view of Endo et al. '239. JP 11005127 further shows an oil channel

(55,39,41,43,45) for guiding oil supplied from the ram (via 55) to the tap within the downward movement transmitter and the tap holder (via 39,41,43,45). JP 11005127 further shows an elastic member (35) which can freely transmit downward motion of the ram at the downward movement transmitter to lower the tap holder against upward energizing force of the tap holder. JP 11005127 lacks work piece brace rotatably provided at a lower end of the shank body.

Endo et al. '239 shows in Figures 1-5 a tapping device (3,5,7,9,11) comprising a tap holder (37A,37B) provided in a shank body (27) and a work piece brace (piece at bottom of 27 at 49A,49B) rotatably provided at a lower end of the shank body. In view of this teaching of Endo et al. '239, it would have been obvious to one of ordinary skill in the art to modify the tapping device of JP 11005127 to include a work piece brace on the shank body as taught by Endo et al. '239 to provide a direct means to secure/stabilize the work piece in place for improved tapping accuracy and efficiency.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT  
Examiner  
3 December 2007

*Monica S. Carter*  
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SUPERVISORY PATENT EXAMINER